REMARKS

Prior to this amendment, claims 1-51 were pending in the present application. By virtue of this response, claims 1, 9, 17, 25, and 51 have been amended. Reconsideration and allowance of the pending claims are respectfully requested. Support for the amendment to claims 1, 9, 17, 25, and 51 may be found, for example, in the claims as originally presented. No new matter has been added. Accordingly, claims 1-51 are currently pending. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Rejection under 35 U.S.C. §103(a)

A. Claims 1-6, 8-14, 16-22, 24-31, 32-34, 38-43, and 46-51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matouk et al. (U.S. Patent No. 4,691,274) in view of Dubin (U.S. Patent No. 5,971,506). The Examiner states, in part:

> With respect to claims 1-6, 8-14, 16-22, 24-31, 32-34, 38-43, and 46-51, Matouk et al. teaches at least two modules (41, 42, 43) comprising at least one heat-generating component, each module (41, 42, 43) adapted to permit air to flow in the module such that airflow goes through, over, or adjacent to the at least one heat-generating component to cool the at least one heat-generating component (Emphasis added.)

Applicant previously argued that Matouk discloses that cooling air flows vertically in the "vertically disposed space" and passes adjacent to the modules, cooling the modules by conduction through the exterior walls such that the cooling air does not flow in or through the modules as asserted by the Examiner. The Examiner states in response to Applicant's argument, in part:

> ...Matouk et al. does in fact teaches each module being "adapted to" permit air to flow in the module such that airflow goes through, over or adjacent to the at least one heat-generating component. Applicant is directed to figures 5 and 6, which show modules (42, 42 respectfully). As can be seen, neither module (42, 43) is completely enclosed (i.e. having top, bottom and sides) to prevent airflow "in or through" the modules such

> that air flow through, over or adjacent the at least one the generating component as claimed.

Applicants respectfully disagree with the Examiner's rejection and submit the Examiner is clearly ignoring features of claim 1 (claim 1 has been amended as indicated herein to add clarity to certain features). In particular, claim 1 recites, in part:

> ...each computer comprising at least one heat-generating component; and
>
> a rack configured for the at least two computers to be placed in a back-to-back configuration, wherein
>
> air is permitted to flow through each computer such that airflow goes through, over, or adjacent to the at least one heat-generating component, and
>
> the rack and computers will cooperate to direct the airflow through the computers (1) up to exit the rack through an upper section of the rack, (2) down to exit the rack through a lower section of the rack, or (3) both.
>
> (Emphasis added).

In contrast, Matouk teaches, in part:

> A plurality of power modules are disposed in the framework and have heat sinks extending into the vertically disposed space, means for forcing air in a vertical direction through the space. (Col. 2, lines 35-39.)
>
> Cooling for the RTC module is accomplished by conduction from the exterior walls of the module into the room and also into the compartment 22 through which the air is passing. (Col. 4, lines 54-57; emphasis added.)

Even if one assumes modules 42 and 43 of Matouk are adapted to allow or permit an airflow to pass therethrough (as asserted by the Examiner), Matouk clearly fails to disclose or suggest that such an airflow (passing through modules 42 and 42) is also directed up, down, or both to exit the framework. In particular, Matouk does not disclose or suggest modules 42 or 43 within a rack or framework such that "air is permitted to flow through each computer such that airflow goes through, over, or adjacent to the at least one heat-generating component, and the rack and computers will cooperate to direct the airflow through the computers (1) up to exit the rack through an upper

section of the rack, (2) down to exit the rack through a lower section of the rack, or (3) both," as required by the present features of claim 1. In clear contrast, Matouk discloses that air flows vertically through the "vertically disposed space" and passes adjacent to the modules, cooling the modules by conduction through heat sinks extending into the vertically disposed space. (Matouk, col. 2, lines 31-39). There is no disclosure or suggestion that airflow passes through modules 42 and 43, and the same airflow which passes through modules 42 and 43 is also directed up (or down) to exit through the vertically disposed space of the framework.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness because the references fail to teach each and every feature of the present claims. Furthermore, the addition of Dubin does not suggest a configuration of computers within rack that produces an airflow as presently recited (nor is the addition of Dubin alleged to suggest this feature).

Furthermore, Applicants traverse the Examiner's assertion that it would have been obvious to incorporate the computer of Dubin into the rack of Matouk et al. to meet the features of the present claims. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987)). The showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999). The initial burden is on the Examiner to establish not only that there is some suggestion of the desirability of doing what the inventor has done, but also that the combination itself is suggested, and further that the skilled artisan would have a reasonable expectation of success that the combination would result in the claimed invention. The Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

There is no teaching in either Matouk or Dubin for any modification of the type suggested in the Office Action. General conclusions concerning what is "basic knowledge" or

"common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. See *In re Thrift*, 298 F.3d 1357, at 1364 (Fed. Cir. 2002), *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *Dembiczak*, 175 F.3d at 999.

Indeed, Matouk relates to a modular electronic power supply, not a computer rack. There is no suggestion or motivation for combining the references as proposed. In addition, the specification in Dubin suggests that the modification proposed by the Examiner would inhibit the operability of the computer in Dubin. Specifically, Dubin states: "a back plate 141 containing openings 142 for connecting cords, an opening 144 for power and exit air, and an opening 148 for access to vertically mounted circuit boards." (Col. 2, lines 54-56.) The Examiner points out that this cited portion is describing the prior art, however, at col. 2, lines 66, it is clear that chassis 140, including openings 142, 144, and 148 as described above, "is surrounded by the mounting system 10 of the present invention." (Col. 2, line 66-Col. 3, line 1). The computer and mounting system of Dubin therefore does include openings 142, 144, and 148 positioned at the backside. Accordingly, if the computers in Dubin were positioned in a back-to-back orientation into the rack of Matouk, as proposed by the Examiner, the openings 142 in the back plate 141 would no longer be accessible, thereby inhibiting the connection of cords and access through the opening 148 to the vertically mounted circuit boards. Consequently, the proposed combination of references is unsupported and inappropriate. Applicants respectfully request that the Examiner withdraw the rejection of claim 1 and claims 2-8, which depend from claim 1.

For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness of independent claims 9, 17, 25, 33, 42, and 51. Applicants respectfully request allowance of these claims and claims 10-16, 18-24, 26-32, 34-41, and 43-50 which depend from claims 9, 17, 25, 33, 42, and 51.

B. Claims 7, 15, 23, 31, 35, 36, 44 and 45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matouk et al. (4,691,274) in view of Dubin (5,971,506) as applied to the claims above, and further in view of Wrycraft (6,011,689).

Claims 7, 15, 23, 31, 35, 36, 44 and 45 depend from independent claims 1, 9, 17, 25, 33, 42, and 51 respectfully and are allowable over the combination of references for at least similar reasons as discussed above.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 443452000103. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By _____

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